



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,351	07/09/2003	Edward Enyedy	LEE 2 00308	1545

7590 09/24/2004

Robert V. Vickers
Fay, Sharpe, Fagan, Minnich & McKee, LLP
7th Floor
1100 Superior Avenue
Cleveland, OH 44114-2579

EXAMINER

JILLIONS, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

3654

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,351

Applicant(s)

ENYEDY, EDWARD

Examiner

John M. Jillions

Art Unit

3654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/9/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 3654

DETAILED ACTION

Election/Restrictions

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-24, drawn to a drive roller or a drive roller feeding system, classified in class 226, subclass 190.
 - II. Claim 25, drawn to a method of making a drive roller, classified in class 427, subclass 523.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as by vapor disposition.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because the searches for the two groups are not coextensive restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Vickers on 8/26/04 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-24. Affirmation of this election must be made by applicant in replying to this Office action. Claim 25 is withdrawn

Art Unit: 3654

from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Claim 25 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 13, 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13, lines 7-8, "said driver roller" is without proper antecedent basis. This should be "each said drive roller". In claim 23, line 2 "a second groove" is unclear since no "first" groove has been previously recited. In claim 24, line 1, "said groove" is without antecedent basis. Apparently claims 23-24 were meant to depend from claim 13, not claim 12.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3654

9. Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kokaji et al.

The roller 42 of Kokaji et al is a drive roller, col. 13, lines 46-47, that can be hardened with chromium, col. 13, lines 11-17. The preamble of these claims “for use on a wire feeding mechanism” is a suggested use of the device and of no patentable significance.

10. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by McBride.

McBride discloses a drive roller 18 having an outer protective thin plating of nickel, col. 2, lines 65-67. The preamble again is of no patentable significance.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kokaji et al.

To make the chrome plating of Kokaji et al a chrome “alloy” as recited in claim 2 would have been an obvious design consideration to one of ordinary skill in the art since most metals are not completely made of one material when used as coatings or platings and the use of such alloys are old and well known to persons of ordinary skill in the art. Likewise the amount of chrome in such an alloy as recited in claim 3 would have been obvious to one of ordinary skill in the art for the same reason. With respect to claim 4, note that the hardness of the roller of Kokaji et al is preferably more than 61 RC, see the paragraph beginning on line 11 of col. 13. Thus it would appear to have been obvious to one of ordinary skill in the art to make the roller of Kokaji et al

Art Unit: 3654

of at least 70 RC, slightly harder than what is disclosed by Kokaji et al since one of ordinary skill in the art would have known how to make such rollers harder to prevent damage thereto.

Regarding claim 5 note that a protective coating on the drum 21 of Kokaji et al may be in the range of 10 microns, col. 7, lines 52-59, which is the same as .0004 inches as recited. Thus it would have been obvious to one of ordinary skill in the art to make the plating on the drive roller 42 of a thickness as claimed as further taught in Kokaji et al that the thickness of the hardness plating of the recording drum 21 should be about the same thickness.

13. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over McBride in view of Kokaji et al. It would have been obvious to one of ordinary skill in the art to make the hardness of the roller of McBride approximately Rockwell C 60 as recited in claim 7 and the thickness of about .0001 to .003 inches as recited in claim 8 as taught by Kokaji et al, col. 13, line 13 and col. 7, line 54 respectively. Such thicknesses and hardness' of plated rollers are well within the purview and knowledge of one of ordinary skill in the art.

Claim Rejections - 35 USC § 103

14. Claims 1-5, 9-18, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ullman in view of Kokaji et al. Ullman discloses an old and well known double-grooved wire drive roller 6, 8. It would have been obvious to one of ordinary skill in the art to provide the outer surface of the rollers with a hardness plating or coating especially in view of the teaching of Kokaji et al that a hardness coating on the outer surface of a drive roller would prevent damage to and prolong the life of the roller. Again the use of a chrome "alloy" and the particular hardness as claimed would have been obvious from Kokaji et al and the thickness is disclosed in

Art Unit: 3654

Kokaji et al and one of ordinary skill in the art would have used such hardness' and thicknesses for a protective coating in view of the teaching of Kokaji et al as pointed out previously.

15. Claims 6-8, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ullman in view of McBride and Kokaji et al. It would have been obvious to one of ordinary skill in the art to provide the outer surface of the drive rollers of Ullman with a protective coating of nickel in view of the teaching of McBride. It would have been also obvious to make the hardness and thickness of the dimensions claimed as further taught by Kokaji et al for the reasons noted previously.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kurisu et al, Muller, Sato et al, Schmitt, Niemi et al, Pospisil et al and Broaddus are cited to show other rollers having outer platings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Jillions whose telephone number is (703) 308-2685. The examiner can normally be reached on M-F 9:15 - 5:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on (703) 308-2688. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3654

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John M. Jillions
Primary Examiner
Art Unit 3654

jmj